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10 AESTHETIC SKIN SYSTEMS LLC

11 IN THE UNITED STATES DISTRICT COURT
12 FOR THE CENTRAL DISTRICT OF CALIFORNIA- WESTERN DIVISION

14 EDGE SYSTEMS LLC, a California
15 limited liability company, and AXIA
MEDSCIENCE, LLC, a Delaware
16 limited liability company,

)CASE NO.: 2:17-cv-04597

17 Plaintiffs,
18 v.
19 AESTHETIC SKIN SYSTEMS LLC, a
California limited liability company
20 Defendants.

)
DEFENDANT AESTHETIC SKIN
SYSTEMS LLC'S MEMORANDUM
IN SUPPORT OF ITS OPENING
CLAIM CONSTRUCTION BRIEF

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1 Defendant Aesthetic Skin Systems LLC, submits this memorandum of
2 points and authorities in support of its Opening Claim Construction.

3 **I. BACKGROUND**

4 This is a case about machines (and parts of machines) that are used in
5 hydrodermabrasion. Hydrodermabrasion is a technique for removing skin layers to
6 have new layers grow in their place. In the late 1990's hydrodermabrasion was an
7 invasive procedure performed exclusively by physicians. Years later, a less
8 invasive version of this procedure became available for estheticians to perform.
9 The line between medical practice performed by a physician and cosmetic practice
10 performed by an esthetician is that, "No [esthetician] shall perform services upon a
11 surface of the skin or scalp where such skin is inflamed or broken (e.g., abraded,
12 cut), or where a skin infection or eruption is present." 16 Cal. Code Reg. 984(e).
13 Physicians can inflame, break, abrade, and cut skin whereas estheticians engage in
14 superficial exfoliation. Anatomically, the difference is that physicians can tear
15 skin down to the stratum corneum but estheticians cannot do so. (Declaration of
16 Nathaniel Coleman at ¶ 17)(Hereinafter "Coleman Decl.").

17 Resolution of the case would greatly benefit from construction of two words
18 that reappear throughout the claim construction terms: abrade and sharp. Most of
19 the briefing below focuses on those two terms in over a dozen contexts.

20 There are two families of patents at issue in this case. U.S. Patent 6,641,591
21 ("the '591 patent") is the first patent of the "Shadduck patents." (Exhibit A). U.S.
22 Patent 7,789,886 ("the '886 patent") comes from a continuation application of the
23 '591 patent. (Exhibit G). U.S. Patent 7,678,120 ("the '120 patent") comes from a
24 continuation application of the '886 patent. (Exhibit E). U.S. Patent 8,066,716
25 ("the '716 patent") also comes from a continuation application of the '886 patent.
26 (Exhibit O). U.S. Patent 8,337,513 ("the '513 patent") comes from a divisional
27 application of the '886 patent. (Exhibit R). U.S. Patent 9,468,464 ("the '464
28 patent") comes from a continuation application of U.S. Patent Application

1 13/620,164 ("the '164 application") which is currently pending. (Exhibit T). The
 2 '164 application is a continuation of '513 patent and is not a part of this litigation.

3 U.S. Patent 8,048,089 ("the '089 patent) is the first patent in the "Ignon
 4 patents." (Exhibit K). U.S. Patent 9,550,052 comes from a continuation application
 5 of U.S. Patent 9,474,886 which is not asserted in the present litigation. U.S. Patent
 6 9,474,886 comes from a continuation application of the '089 patent. (Exhibit W).

7 **II. THE CLAIM TERMS AT ISSUE MUST BE CONSTRUED IN
 8 ACCORDANCE WITH THE PROSECUTION HISTORY**

9 Claim terms "are generally given their ordinary and customary meaning,"
 10 which is "the meaning that the term would have to a person of ordinary skill in the
 11 art in question at the time of the invention." *Phillips v. AWH Corp.*, 415 F.3d 1303,
 12 1312-13 (Fed. Cir. 2005) (en banc) (citations omitted). To determine this meaning,
 13 "the court starts the decision making process by reviewing the same resources as
 14 would that person, viz., the patent specification and prosecution history." *Id.*.

15 Claims "must be read in view of the specification, of which they are a part."
 16 *Id.* at 1315 (citation omitted). The specification "is always highly relevant to the
 17 claim construction analysis. Usually, it is dispositive; it is the single best guide to
 18 the meaning of a disputed term." *Id.* (citation omitted). "[T]he specification may
 19 reveal a special definition given to a claim term by the patentee that differs from
 20 the meaning it would otherwise possess. In such cases, the inventor's lexicography
 21 governs." *Id.* at 1316. In reviewing the specification, a court should strive to
 22 capture the scope of the actual invention and not allow the claim language to
 23 become divorced from what the specification conveys is the invention. *Id.* at
 24 1323-24.

25 A court "should also consider the patent's prosecution history, if it is in
 26 evidence." *Phillips, supra*, 415 F.3d at 1317 (citation omitted). "[T]he prosecution
 27 history can often inform the meaning of the claim language by demonstrating how
 28 the inventor understood the invention and whether the inventor limited the

1 invention in the course of prosecution, making the claim scope narrower than it
 2 would otherwise be." *Id.*

3 Additionally, a court may rely on extrinsic evidence, which "consists of all
 4 evidence external to the patent and prosecution history, including expert and
 5 inventor testimony, dictionaries, and learned treatises." *Id.* (citation omitted).
 6 Technical dictionaries may be especially useful to help a court "better understand
 7 the underlying technology and the way in which one of skill in the art might use
 8 the claim terms." *Id.* at 1318 (citation omitted). In addition, expert testimony may
 9 "provide background on the technology at issue, to explain how an invention
 10 works, to ensure that the court's understanding of the technical aspects of the patent
 11 is consistent with that of a person of skill in the art, or to establish that a particular
 12 term in the patent or the prior art has a particular meaning in the pertinent field." *Id.*

13 Furthermore, based upon the doctrine of prosecution disclaimer, an applicant
 14 cannot recapture claim scope that was surrendered or disclaimed during
 15 prosecution of a parent application unless the prosecution history is sufficiently
 16 clear to inform the examiner that the previous disclaimer, and the prior art that it
 17 was made to avoid, may need to be revisited. *See Hakim v. Cannon Avent Group,*
 18 *PLC*, 479 F.3d 1313, 1317-1318 (Fed. Cir. 2007).

19 **III. DEFENDANT'S CLAIM TERM INTERPRETATIONS**

20 **A. U.S. Patent No. 6,641,591**

21 The '591 patent is an original non-provisional application.

22 **1. Claim 1**

23 The limitation, "an abrading structure with substantially sharp edges for
 24 abrading tissue" should be interpreted to mean, "There are at least two edges that
 25 come together with a sharp margin of intersection to form a cutting edge that tear
 26 skin as if done by teeth...."

27 ///

28 ///

1 In prosecution, the “abrading structure” was defined by the examiner as
 2 anything that could remove skin (Exhibit B, at 95). The examiner indicated that
 3 this element was found in U.S. Patent 6,139,554 issued to Maurice Karkar (the
 4 “‘554 patent”, Exhibit C). The ‘554 patent taught a tip with hole through a conical
 5 end. The examiner reasoned that rubbing a flat surface with a hole over skin
 6 would remove some skin. (Exhibit C, at 44-45). The applicant responded that the
 7 present invention removed even more skin than the ‘554 patent because the
 8 claimed invention used “an instrument with a working surface that carries sharp-
 9 edged apices in a rasp-like or sandpaper-like structure.” (Id., at 96).

10 The term, “substantially sharp edges” thus means “at least two edges that
 11 come together with a sharp margin of intersection to form a cutting edge” which is
 12 very close to the definition described in the file history. The term, “for abrading
 13 tissue” can be found in the specification of the ‘591 patent at Col. 5, ln, 64-66,
 14 (“these primary surface elements 255a and secondary surface elements thereby
 15 define teeth 65 therebetween that seem well suited to abrading skin layers....”) The
 16 term refers to tearing skin with teeth. (Exhibit A, at 13).

17 Plaintiffs’ proposed construction is anticipated by the ‘554 patent. The
 18 plaintiff stated in the file history that the claimed invention is different than the
 19 ‘554 patent, so plaintiffs’ definition is not a precise as the one proffered by the
 20 Defendant. Coleman Decl., ¶ 10).

21 **2. Claim 4**

22 The claim term, “shape irregularities comprising distally projecting apices
 23 and recessed portions therebetween” should be construed to mean, “a first apex is
 24 formed from two edges that terminate at a first point extended above the skin
 25 interface portion. A second apex is formed by two additional edges that terminate
 26 at a second point extended above the skin interface portion. A recessed portion is
 27 between the first apex and the second apex.”

28 / / /

1 Mr. Coleman explains that “an apex is something that rises to a point. To
 2 rise to a point, an apex needs two edges.” Coleman Decl., ¶ 12. If there are at least
 3 two apexes, there needs to be at least four edges. The prosecution history points
 4 out that “edges” means “sharp edges” in this context. (Exhibit A, at 95).

5 The plaintiff would prefer to use the construction of, “a ridged surface
 6 having peaks that extend upward with valleys between them....” However, this
 7 construction can include rounded peaks, and the only peaks described in the
 8 application are sharp peaks made from two sharp edges. Coleman Decl., ¶ 13-14.
 9 Plaintiffs’ proposed definition conspicuously omits to the invasive procedure being
 10 taught by the specification.

11 **3. Claim 10**

12 The claim term, “the combination of an abrasive structure carried by the
 13 treatment device and the flowable treatment medium removes dermal tissue”
 14 should be construed to mean “A structure on the treatment device that inflames,
 15 breaks, irritates or cuts the skin located below the epidermis beyond the reach of an
 16 esthetician that is conducting a superficial exfoliation. The skin located below the
 17 epidermis is then removed by the treatment medium.”

18 As noted above, “an abrasive structure” is “a structure on the treatment
 19 device that inflames, breaks, irritates or cuts the skin located below the epidermis
 20 beyond the reach of an esthetician that is conducting a superficial exfoliation.”
 21 This abrasive structure then tears through the stratum cornum and removes skin
 22 from below the stratum cornum which is then washed away with the treatment
 23 medium. Coleman Decl., ¶ 17.

24 Plaintiffs proffer that a better claim construction would be, “an abrasive
 25 structure on the treatment device and the flow of treatment medium at the
 26 treatment region work together to remove dermal tissue....” However, Mr.
 27 Coleman notes plaintiffs’ claims construction is inconsistent with the specification
 28 because the specification details a two-step process of (1) teeth tearing away a

1 meaningful amount of skin tissue, and (2) washing the torn skin away. *Id.* In
 2 comparison, Defendant's definition comports with the specification.

3 **B. U.S. Patent No. 7,678,120**

4 The '120 patent is a continuation of both the '886 patent and the '591 patent.
 5 (Exhibit E, p. 12, col 1. ln 9-10). The applicant explains in the file history that,
 6 "Applicant notes for the record that the claims of the present application are
 7 different and may be broader in scope than the claims in any related patent or
 8 application. To the extent that any statements made in a related case (such as
 9 amendments or characterizations regarding the scope of a claim or prior art) could
 10 be construed as a disclaimer of any subject matter supported by the present
 11 disclosure, Applicant rescinds and retracts such disclaimer." (Exhibit F, at 79).
 12 This is impermissible recapture under *Hakim*, 479 F.3d, at 1317-1318. In *Hakim*
 13 the Federal Circuit noted that arguments and previous waivers of claimed material
 14 narrowed in view of art cited by the examiner must be *specifically* disclaimed.
 15 Like in *Hakim*, *supra*, the attorney filed a letter stating that claims were being
 16 broadened in the child application, and, therefore, required further examination.
 17 However, there was no discussion of specific prior art or arguments previously
 18 used in the attorney's letter to the examiner. *Hakim*, 479 F.3d at 1318 ("A patentee
 19 may not state during prosecution that the claims do not cover a particular device
 20 and then change position and later sue a party who makes that same device for
 21 infringement."). Accordingly, all previous narrowing amendments remain in
 22 effect.

23 **4. Claim 1 – First Contested Claim Term**

24 The claim term, "an abrading surface on a skin interface on the working end
 25 of the skin treatment device" should be construed to mean, "A structure on a skin
 26 interface on the working end of the skin treatment device that inflames, breaks,
 27 irritates or cuts the skin located below the epidermis beyond the reach of an
 28 esthetician that is conducting a superficial exfoliation..." for substantially the same

1 reasons discussed above. Plaintiffs' construction is inadequate for the same
 2 reasons discussed above in Section IV.A1 regarding "the abrasive structure."

3 **5. Claim 1 – Second Contested Claim Term**

4 The claim term, "the abrading surface comprising apexes extending
 5 upwardly from the abrading surface and the apexes having sharp edges" should be
 6 constructed to mean, "a first apex is formed from two sharp edges that terminate at
 7 a first point extended above the skin interface portion. A second apex is formed by
 8 two sharp edges that terminate at a second point extended above the skin interface
 9 portion. A recessed portion is between the first apex and the second apex...."

10 In addition to the reasons cited above in section IV.A.2, the examiner
 11 explains during prosecution, "the prior art of reference does not disclose a method
 12 for abrading skin of a patient with a device comprising a suction source and
 13 especially [an] abrading surface comprising apexes having *sharp* edges extending
 14 upwardly from the abrading surface." (Exhibit F, p. 35-37). Mr. Coleman keenly
 15 points out that the requirement of "sharp" edges actually makes this claim term
 16 narrower than that found in the '120 application. Coleman Decl., ¶ 23.

17 **C. U.S. Patent No. 7,789,886**

18 The '886 patent is a continuation of '591 patent and makes the same
 19 impermissible recapture attempt as the '120 patent. (Exhibit H, p. 63-63). All of
 20 the waivers and limitations of the '120 patent's file history apply to the '886 patent
 21 as well. *Hakim*, 479 F.3d at 1317-1318.

22 **6. Claim 1 – First Contested Term**

23 The claim term, "an abrading structure comprising a plurality of sharp
 24 elements for engaging and abrading the skin surface" should be construed to be,
 25 "A structure that inflames, breaks, irritates or cuts the skin located below the
 26 epidermis beyond the reach of an esthetician that is conducting a superficial
 27 exfoliation; at least two sharp elements. Each sharp element has a sharp margin of
 28 intersection to form a cutting edge that tears skin as if done by teeth...."

1 The scope of the ‘886 Patent was narrowed twice. First, in response to the
 2 ‘591 patent, the applicant argued that a bored hole failed to abrade skin in the same
 3 manner as a rasp or sand paper. *Supra*. Further, the applicant again narrowed the
 4 ‘886 patent in response to assertion of U.S. Patent 6,423,078 issued to Medtronic
 5 Xomed, Inc. (the “078 patent”, Exhibit I) which teaches a tip covered with an
 6 abrasive surface. (Exhibit I, p. 6 ln. 66-67). The applicant traversed these
 7 references by narrowing the claim with the addition of “a plurality of sharp
 8 elements” on the working end. (Exhibit H, p. 57). As Mr. Coleman explains,
 9 “Unlike, the ‘120 patent, the “sandpaper” argument does not appear in the file
 10 history of the ‘886 patent because [the ‘078 patent] is teaching just that, so the
 11 sharp elements here are more narrowly defined than those of the ‘120 patent.”
 12 Coleman Decl., ¶ 26).

13 It follows that the claim construction of the ‘886 patent needs to be narrower
 14 than that of the ‘591 patent based upon its amendments during prosecution.
 15 Interpreting the claim to include “Each sharp element has a sharp margin of
 16 intersection to form a cutting edge that tears skin as if done by teeth” resolved
 17 anticipation in view of the ‘078 patent. Mr. Coleman did not believe that the
 18 plaintiffs’ construction accomplished this stating, “This definition is too broad and
 19 reads on the Bays reference. Simply being sufficiently sharp enough to abrade
 20 skin is what Bays is teaching. The more appropriate contextual definition accounts
 21 for the point of novelty described by the examiner in the file history.” Coleman
 22 Decl., ¶ 28.

23 **7. Claim 1 – Second Contested Term**

24 The claim term, “at least one aperture about said working surface” should be
 25 constructed to mean, “at least one aperture is on every side of or all the way around
 26 the working surface.” The plaintiff proposes the construction, “at least one aperture
 27 [is] in or near the working surface....” This is a disagreement about whether
 28 “about” means “on every side of or all the way around” or “in or near.” Both of

1 these definitions can be found in the COLLINS ENGLISH DICTIONARY (2016).
 2 (Exhibit J, p. 3-4).

3 When a claim term is capable of having two different meanings that are
 4 structurally different then the claim term is undefined, thus the claim fails for
 5 indefiniteness under 35 U.S.C. 112(b). The term “about” is used primarily in the
 6 ‘886 Patent describing approximations regarding measurements and the like. In
 7 one use, the specification describes that “the inner periphery [is] about the edge of
 8 opening 26”, meaning that the inner periphery surrounds or is all the way around
 9 the central opening 26 (vacuum opening in this case), fitting the defendant’s
 10 definition. (Exhibit G, at 14, col. 5, ln. 32-36). The specification does not use the
 11 term “about” when describing the location of the vacuum apertures in relation to
 12 the working surface. In fact, the term “working surface” is not found in the
 13 specification, nor anywhere in the parent application. In the embodiment of the
 14 ‘886 patent shown in Fig. 8, ports 250 surround the skin interface 225 and the port
 15 240. (Id. at 10). As an option with this embodiment, “the vacuum source and fluid
 16 source may be reversed between the first and second aperture arrangements 240
 17 and 250 with the method of skin removal still working well.” (Id., p. 15 col. 7, ln.
 18 44-48). Thus, in this embodiment, the vacuum apertures 250 are situated “on every
 19 side of” and are “near or close to” the skin interface 225. (Id.). Thus, the exact
 20 claimed positional relationship between the working surface and the at least one
 21 aperture is uncertain rendering the claim indefinite and invalid pursuant 35 U.S.C.
 22 §112(b).

23 **8. Claim 11**

24 The claim element, “an abrasive structure configured to abrade the skin
 25 surface” should be construed to mean, “a structure that inflames, breaks, irritates or
 26 cuts the skin located below the epidermis beyond the reach of an esthetician that is
 27 conducting a superficial exfoliation.” This definition is support by all the reasons
 28 stated above in Section IV.A.1.

1 The plaintiff has proposed the construction “an abrasive structure that is
 2 arranged in a way that will allow it to abrade the skin surface....” However, this
 3 definition and scope was already surrendered by the applicant during prosecution.
 4 *See Festo Corp. v Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).
 5 *See Exhibit H at 56-65.*

6 **D. U.S. Patent No. 8,048,089**

7 The ‘089 patent is an original non-provisional application.

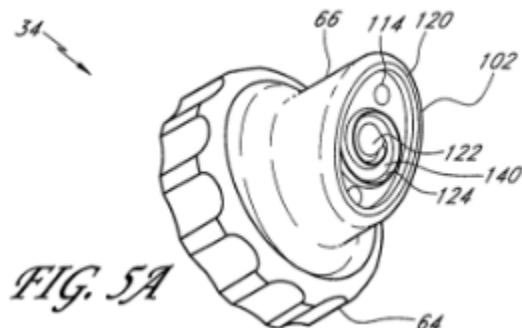
8 **9. Claim 1 – First Claim Term**

9 The claim term, “an outer member extending around a periphery of the distal
 10 face, said outer member defining an inner area” should be construed to be, “the
 11 distal face has a circumferential outer edge that defines an inner area....”

12 As Mr. Coleman explains, “The file history at page 98 notes that the
 13 language ‘outer member’ was selected to stay consistent with the specification.
 14 The specification at column 9 lines 10-14
 15 reads, ‘With respect to FIGS. 5A through
 16 7, the tip 34 comprises an outer member
 17 120 and an inner member 124. The outer
 18 member 120 preferably defines the
 19 periphery of the distal end 102 of the tip
 20 34.’ Figure 5A is shown [above]. This shows the outer edge defines an inner area
 21 of the tip.” Coleman Decl., ¶ 32; Exhibit L, p. 96; Exhibit K, p. 8, p.32 col. 9 ln.
 22 10-14).

23 The plaintiffs’ construction is not consistent with the specification and
 24 Figure 5A. Figure 5A shows that the raised edge portion 120 is set inward from
 25 the tip main body 66. (Exhibit K, p. 8, p.32 col. 9 ln. 10-14). The plaintiffs’
 26 construction is contrary to the express language used by the applicant in the
 27 specification.

28 ///



10. Claim 1 – Second Claim Term

The claim term, “a protruding member extending in a generally spiral fashion across at least a portion of the inner area of the distal face, the protruding member defining a channel between the at least one first passage and the at least one second passage” should be construed to mean, “a curved member that winds around a fixed center point increasing or decreasing distance from the point across at least a portion of the inner area of the distal face, the curved member defines a channel situated within the space separating the first passage and the second passage, but not necessarily connecting the two.”

The term “generally” is a term of degree which, if definite, that modifies “spiral” to significantly broaden the scope of the term. See MPEP, 2173.05(B). Courts have construed the term “generally” when modifying a shape. For example, in *EZ Dock*, the limitation “generally frustoconically shaped pylon” was construed as meaning “a structure that, for the most part, is in the shape of the frustum of a solid having (1) a closed plane base and (2) a surface formed by line segments joining every point of the boundary of the base to a common vertex.” *EZ Dock, Inc. v. Schafer Systems, Inc.*, et al., 2003 U.S. Dist. LEXIS 1810 (D. Minn., Jan. 22, 2003). In *Ethicon Endo-Surgery*, the limitation “a generally hexagonal shape” was construed to “mean that the staple pocket is perceived by a viewer to have six major sides that can have varying lengths.” *Ethicon Endo-Surgery v. Tyco Healthcare Group LP*, 2006 U.S. Dist. LEXIS 51187 (S.D. Ohio, July 26, 2006). Thus, a reasonable construction of a shape modified by the term of degree “generally” would not require a mathematically perfect shape but would be broadly limited by the definition of the shape.

Here, the specification does not include a special definition of spiral, and instead, broadly describes the range of spiral angles. “The spiral-like pattern of the inner members 124 in FIGS. 5 through 7 varies. ... In some embodiments, the inner member 124 subtends an angle of about 70°, 135°, 180°, 210°, 225°, 270°,

1 315°, 360°, and angles encompassing such ranges.” (Exhibit K, p. 32, col. 9, ln.
 2 30-41). Thus, the inner member or protruding member is not restricted to a full
 3 360° spiral angle, and can be as little as 70° (and likely less). This means that the
 4 protruding member can be shaped as an arc of a spiral (basically a curve that fits
 5 the definition of a spiral), and is not limited to the commonly of a spiral (the
 6 Archimedean spiral, logarithmic spiral, etc.). *The American Heritage® Dictionary*
 7 *of the English Language*, Fifth Edition (2011) definition of the term “spiral” is “[a]
 8 curve on a plane that winds around a fixed center point at a continuously
 9 increasing or decreasing distance from the point.” (Exhibit M at 3). However, since
 10 the term “generally” strips the term “spiral” of mathematical precision, the
 11 limitation “generally spiral fashion” should be construed as meaning “curve that
 12 winds around a fixed center point increasing or decreasing distance from the
 13 point”.

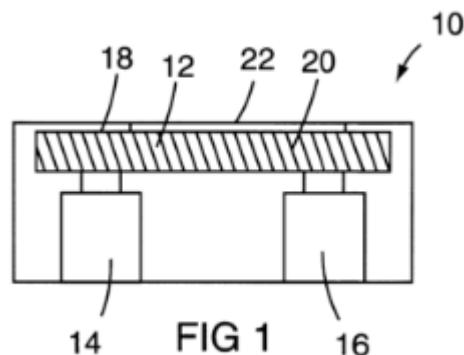
14 Moreover, the limitation “generally spiral fashion” should not be narrowed
 15 to extend from a center portion of the distal face nor should it be narrowed to a
 16 particular spiral angle, since dependent claims 3, 4, and 5 recite these limitations.
 17 Under the doctrine of claim differentiation, there is a presumption that an
 18 independent claim should not be construed as requiring a limitation added by a
 19 dependent claim *See Karlin Tech. Inc. v. Surgical Dynamics Inc.*, 177 F.3d 968, 50
 20 USPQ2d 1465 (Fed. Cir. 1999). This prevents narrowing limitations from being
 21 imported into the independent claim, if that same limitation is found in claim that
 22 depends from the independent claim. Thus, the plaintiff should be held to the broad
 23 language chosen in prosecution.

24 **11. Claim 1 – Third Claim Term**

25 The claim term, “at least one sharp edge configured to abrade skin tissue”
 26 should be construed to mean, “a sharp margin of intersection that forms a cutting
 27 edge that inflames, breaks, irritates or cuts the skin located below the epidermis
 28 beyond the reach of an esthetician that is conducting a superficial exfoliation.”

1 One of the repeating inquiries in this litigation is, “how sharp is sharp?” This
 2 Court has previously defined, “a sharp, forward cutting edge” to mean, “having a
 3 sharp margin of intersection between the top and bottom surfaces of the blade, in
 4 which the surface border defined by that margin also defines the forward most
 5 point of the blade.” *Bausch & Lomb Surgical, Inc. v. Oasis Medical, Inc.*, 2001
 6 U.S. Dist. LEXIS 25880 (C.D. Cal., Jul. 16, 2001).

7 The definition found in *Bausch & Lomb, supra*, fits well with the
 8 prosecution history of the ‘089 patent. The file wrapper reads, “The closest prior
 9 art of record is US 6,277,128 to Muldner which
 10 discloses a skin abrasion device that includes a
 11 spiral member (20, Figs. 1-2) extending
 12 between two fluid passages (14 and 16, Figs. 1-
 13 2). The spiral member taught by Muldner does
 14 not have a sharp edge configured to abrade the
 15 skin, instead an abrasive material travels
 16 through the spiral member (20) taught by Muldner and this material is responsible
 17 for abrading the skin. The examiner considers the protruding member claimed by
 18 applicant to be a novel and unique feature.” (Exhibit L, p. 25). “Figure 1 of
 19 Muldner is shown to the right. Muldner explains, ‘The abrasion chamber 12
 20 shown is generally cylindrical with sidewalls 18 having generally helical or spiral
 21 grooves and/or ridges 20.’ Col. 2. Ln. 35-36. So, a sharp edge is not merely an
 22 edge or even a ridge, it must have something more.” Colemam Decl., ¶ 38; Exhibit
 23 N, at 8, col. 2. ln. 35-36. In that regard, the plaintiff’s construction is too broad and
 24 reads on Muldner rendering the claim unpatentable in view of Muldner.



25 E. U.S. Patent No. 8,066,716

26 The ‘716 patent is a continuation of the’886 patent. As noted above, the
 27 ‘886 patent is a continuation of the ‘591 patent. The ‘716 patent makes the same
 28 impermissible recapture attempt as the ‘120 patent and the ‘886 patent. (Exhibit P,

1 p. 7-8). All of the waivers and limitations of the file histories ‘591 patent and the
 2 ‘886 patent apply to the ‘716 patent as well. *Hakim*, 479 F.3d, at 1317-1318.

3 **12. Claim 1 – First Claim Term**

4 The claim term, “an abrading structure” should be construed to mean, “a
 5 structure that inflames, breaks, irritates or cuts the skin located below the
 6 epidermis beyond the reach of an esthetician that is conducting a superficial
 7 exfoliation.”

8 During prosecution, the ‘716 application received a rejection based on U.S.
 9 Patent 6,162,232 issued to Shadduck. The examiner points out in the file history
 10 that, “body 8A (Shadduck-‘232: C
 11 L 15-31) is qualified as an ‘abrading
 12 structure’” configured to selectively
 13 abrade skin, because body 8A as
 14 shown in Fig. 3A above includes
 15 slot 41A to receive abrading
 16 structure 8B to abrade skin at an
 17 selective angle. Notice that an
 18 ‘abrading structure’ only requires a structure, which somehow serves the purpose
 19 of abrading a skin.” (Exhibit P, at 72). To overcome this rejection the applicant
 20 added the limitation of a plurality of ridge elements.

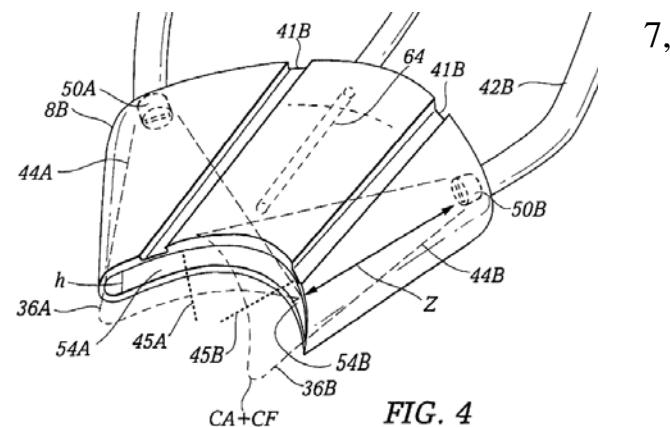


FIG. 4

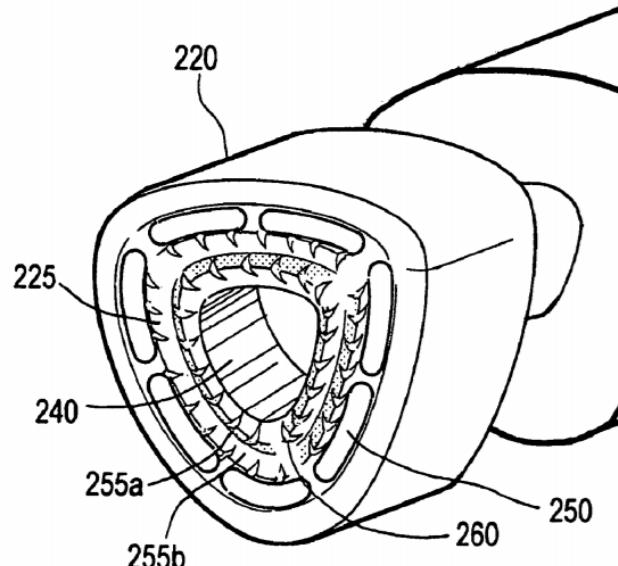
21 The examiner concluded the ridge elements were unique and wrote,
 22 “Shadduck [referring to U.S. Patent 6,162,232] does not disclose an abrading
 23 structure comprising a plurality of ridge elements or other abrading elements
 24 configured to abrade skin. Instead, it appears that the various embodiments
 25 discussed and illustrated in Shadduck provide for the removal of a patient’s dermal
 26 layers using abrasive crystals. In addition, Shadduck fails to teach or suggest a
 27 working end having an outer periphery that circumscribes or surrounds an abrading
 28 structure. (Exhibit P, at 51).

1 Mr. Coleman explains that the file history shows a narrower definition than
 2 that proposed by the plaintiffs is appropriate. The plaintiffs' construction, "is
 3 inconsistent with the file history which specifies that Shadduck does not teach an
 4 abrading structure and Shadduck would, necessarily wear away at least some
 5 trivial amount skin by mechanical action. An abrading structure, therefore is more
 6 than merely a structure that can wear away with mechanical action. The
 7 defendant's construction is consistent with the file history." Coleman Decl., ¶ 44.

8 **13. Claim 1 – Second Claim Term**

9 The claim term, "a plurality of ridge elements, wherein said ridge elements
 10 are configured to abrade skin" should be construed as, "edges that extend
 11 outward from the skin interface which remove more skin tissue than an esthetician
 12 that is conducting a superficial exfoliation."

13 The specification explains, with reference to the figure below, "The skin
 14 interface has a series of primary
 15 ridge elements 255a and valley
 16 elements 255b together the
 17 secondary notches or grooves 260
 18 as defined above with similar
 19 dimensional parameters. This
 20 embodiment differs however in that
 21 the apexes of ridge elements 255a
 22 are substantially a sharp edge as are
 23 the edges of the notches 260."
 24 (Exhibit O, at 15, col. 7, ln. 43-47).



25 Mr. Coleman points out that application of the plaintiffs' construction is too
 26 broad resulting in the '716 patent device being anticipated by the '232 patent.
 27 Coleman Decl., ¶42-47.

28 ///

1 **14. Claim 11**

2 The claim term, “a plurality of abrading elements configured to abrade skin,
 3 wherein each abrading element comprises a sharp edge” should be construed to
 4 mean, “a plurality of elements such that each element has a sharp margin of
 5 intersection to form a cutting edge that inflames, breaks, irritates or cuts the skin
 6 located below the epidermis beyond the reach of an esthetician that is conducting a
 7 superficial exfoliation.”

8 Mr. Coleman explains that, “the cutting edge in Karkar [and] that of the ‘232
 9 patent are structurally similar. Both can remove some skin by rubbing, but
 10 abrading skin in this context means much more. The abrasion necessary involves
 11 more than superficial exfoliation [.] This abrasion requires a cutting edge that is
 12 formed from the sharp margin of intersection.” Coleman Decl., ¶ 48.

13 Again, the plaintiffs’ proposed construction is indistinguishable from the
 14 ‘232 patent because it omits the inventive structure of the claim rendering the ‘716
 15 patent device anticipated by the ‘232 Patent if plaintiffs’ definition is applied.

16 **F. U.S. Patent No. 8,337,513**

17 The ‘513 patent is a continuation of the ‘886 patent, which, as noted above is
 18 a continuation of the ‘591 patent. (Exhibit R, p. 12 col. 1 ln. 7-10). The ‘513
 19 patent makes the same impermissible recapture attempt as the ‘120 patent and the
 20 ‘886 patent. (Exhibit S. p. 96). All of the waivers and limitations of the file
 21 histories ‘591 patent and the ‘886 patent apply to the ‘513 patent as well. *Hakim*,
 22 479 F.3d, at 1317-1318.

23 **15. Claim 1**

24 The claim term “at least one sharp edge configured to abrade skin” should be
 25 constructed to be, “a sharp margin of intersection forming a cutting edge that
 26 inflames, breaks, irritates or cuts the skin located below the epidermis beyond the
 27 reach of an esthetician that is conducting a superficial exfoliation....”

28 ///

1 The claims as originally presented were cancelled after a rejection in view of
 2 the ‘185 patent (Exhibit D) and the ‘078 patent (Exhibit I). (Exhibit S, p. 80). The
 3 new claims were allowed, according to the examiner because, “especially the
 4 aperture and the abrading structure are circumscribed within an outer
 5 circumference contacting a skin so that the vacuum source will effectively suck
 6 away the skin debris through the at least aperture.” (Exhibit S, at 26).

7 Plaintiff has proposed the construction, “at least one edge that is sufficiently
 8 sharp to abrade skin and is arranged in a way that will allow it to abrade skin.” Mr.
 9 Coleman explains, “[t]he difficulty is that Grinberg [the ‘185 patent] has the
 10 opening which has an edge that can remove some trivial amount of skin as the
 11 examiner notes at page 145 in the file history. Further, the grit tip on Bays [‘078
 12 patent] can abrade skin as well. The plaintiff’s construction does not distinguish
 13 the Grinberg and Bays reference, though the plaintiffs stated these references were
 14 different [from the claimed invention] in the file history.” Coleman Decl., ¶ 53.
 15 Plaintiffs construction is impermissible pursuant to *Festo Corp. supra*.

16 **16. Claim 10**

17 The term, “selectively abrade skin” is not defined and is not found in the
 18 specification or drawings as originally filed in the ‘591 patent. Mr. Coleman
 19 explains, “If I were going to create a definition for this, I would say that it means a
 20 very small surface area of skin is removed whereas immediately adjacent skin is
 21 not abraded.” Coleman Decl., ¶ 54.

22 The claim element, “at least one surface element configured to selectively
 23 abrade skin” should be construed to mean, “at least one tooth that is created by a
 24 primary surface element and a secondary surface element with a valley
 25 therebetween.” The specification support for this is the same as set forth in IV.E13,
 26 *infra*. The plaintiffs suggest “at least one element arranged in a way that will allow
 27 it to abrade a selected area of skin.” Mr. Coleman emphasizes, “The problem is
 28 that this is what the Bays reference [‘078 patent] is doing and the applicant said

1 that Bays is not teaching an abrasive structure.” Coleman Decl., ¶ 56. The
 2 plaintiffs’ construction does not align as well as the defendant’s construction with
 3 the prosecution history.

4 **G. U.S. Patent No. 9,468,464**

5 The ‘464 patent is a continuation of U.S. Patent Application 13/620,164
 6 (“the ‘164 application”) which currently pends. The ‘164 application is a
 7 continuation application of the ‘513 patent. The ‘513 patent is based on a
 8 divisional application of the ‘886 patent. The ‘886 patent is a continuation of the
 9 ‘591 patent as noted above. (Exhibit T, at 14, col. 1 ln. 6-13). The ‘464 patent
 10 makes the same impermissible recapture attempt as the ‘120 patent and the ‘886
 11 patent. (Exhibit U, at 52-53). All of the waivers and limitations of the file
 12 histories ‘591 patent, the ‘886 patent, and the ‘513 patent apply to the ‘464 patent
 13 as well. *Hakim*, 479 F.3d, at 1317-1318.

14 **17. Claim 1**

15 The claim limitation “activating the vacuum source to simultaneously
 16 deliver a treatment media to the skin surface through the at least second port,
 17 wherein the treatment media comprises a liquid, and to aspirate spent treatment
 18 media through the at least one first port and the at least one passageway, thereby
 19 selectively providing a volume of the treatment media to the skin surface of the
 20 subject” should be construed to read, “activating the vacuum source to
 21 simultaneously: 1. deliver a treatment media to the skin surface through the at least
 22 second port; and 2. aspirate spent treatment media through the at least one first port
 23 and the at least one passageway; using the vacuum source to control the following:
 24 providing a first volume of the treatment media to the skin surface of the subject;
 25 and providing a second volume of the treatment media to a location other than the
 26 skin surface of the subject.”

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1 The latter part of this claim limitation was added to traverse a rejection
2 based on U.S. Patent No. 6,193,589 issued to Khalaj (“the ‘589 patent”). (Exhibit
3 V). The examiner believed that this addition was the inventive step and explained
4 in the reasons for allowance, “the prior art of reference has failed to disclose or
5 suggest a method for using a handheld device to treat a human skin comprising
6 positioning the handheld device against a skin surface, activating a vacuum source
7 to simultaneously deliver a treatment liquid, to aspirate the spent treatment liquid
8 and to facilitate delivery the treatment liquid to a subsurface skin tissue.” (Exhibit
9 U, at 19). The applicant’s interview summary relating to this amendment notes
10 that the constructed limitation was discussed as an inventive step. (Id. at p. 112).
11 Mr. Coleman explains the difference between the claimed invention and Khalaj
12 [“the ‘589 patent”]: “The difference between the constructed claim limitation and
13 Khalaj is that the vacuum in the ‘464 patent is pulling the media both into the
14 nozzle and out of the nozzle at the same time whereas Khalaj is using a pump to
15 deliver media and a vacuum to remove media.” Coleman Decl., ¶59.

16 The claim indicates that a selected amount of media is delivered to the skin.
17 Seemingly the rest goes elsewhere. Mr. Coleman explains, “The defendant sees it
18 differently, proffering that the vacuum is controlling how much media is being
19 dispensed to the skin surface and how much is going someplace else, presumably
20 being sucked up by the suction port and never contacting the skin surface. The
21 defendant has the better interpretation because it distinguishes the vacuum
22 performing the function of a fluid media pump from using a pump and vacuum as
23 disclosed in Khalaj. Specifically, Khalaj [the ‘589 patent] has a flow restrictor that
24 is controlling the flow of media, the vacuum works with the flow restrictor, but
25 they are different structure. The plaintiffs’ claim construction defines what Khalaj
26 is doing and not what is shown in the specification.” Coleman Decl., ¶61.

27 ///
28 ///

1 **18. Claim 12**

2 The claim element, “activating the vacuum source to simultaneously deliver
 3 a treatment media to the skin surface through the at least second port, and to
 4 aspirate spent treatment media through the at least one first port, thereby
 5 selectively providing a volume of the treatment media to the skin surface of the
 6 subject, wherein the treatment media comprises a liquid” should be construed to
 7 mean, “ activating the vacuum source to simultaneously: 1) deliver a treatment
 8 media to the skin surface through the at least second port; and 2) aspirate spent
 9 treatment media through the at least one first port and the at least one passageway
 10 using the vacuum source to control the following: providing a first volume of the
 11 treatment media to the skin surface of the subject; and providing a second volume
 12 of the treatment media to a location other than the skin surface of the subject.”
 13 This is for the same reason as set forth in Section IV.G17.

14 **H. U.S. Patent No. 9,550,052**

15 The ‘052 patent is a continuation of U.S. Patent 9,474,886, which is not
 16 asserted in this case. U.S. Patent 9,474,886 is a continuation of ‘089 patent.
 17 (Exhibit W, p. 30, col. 1. Ln. 7-10). The ‘052 patent makes the same impermissible
 18 recapture attempt as the other patents above. (Exhibit X. at 65). All of the waivers
 19 and limitations of the file histories of the ‘089 patent apply to the ‘052 patent as
 20 well. *Hakim*, 479 F.3d, at 1317-1318.

21 The claim limitation, “wherein, when the vacuum source is activated and the
 22 tip contacts the skin surface, a suction force is created within the waste conduit and
 23 along the tip, thereby removing waste from the skin surface via the waste conduit
 24 while drawing treatment material from the first fluid container or the second fluid
 25 container to the tip via the supply conduit” should be interpreted to mean,
 26 “wherein, when the vacuum source is activated and the tip contacts the skin
 27 surface, a suction force is created within the waste conduit and along the tip; the
 28 suction force simultaneously: 1) removes waste from the skin surface via the waste

1 conduit; and 2) draws treatment material from the first fluid container or the
 2 second fluid container to the tip via the supply conduit....”

3 The examiner explained in the reason for allowance that the inventive step
 4 here was, “when the vacuum source is activated and the tip contacts the skin
 5 surface, a suction force is created within the waste conduit and along the tip,
 6 thereby removing waste from the skin surface via the waste conduit while drawing
 7 treatment material from the first fluid container or the second fluid container to the
 8 tip via the supply conduit.” This limitation was important because Coleman
 9 (2001/0049511) taught a fluid discharge pump and vacuum combination
 10 substantially like the ‘589 patent above. (Exhibit AA, at 10 ¶¶50, 61). Therefore,
 11 the fluid discharge pump and vacuum are not the inventive step of ‘052 Patent.

12 The plaintiffs’ construction does not emphasize that one vacuum is
 13 performing two tasks at the same time 1) drawing and 2) removing. The removal
 14 is more than incidental or trivial removal that might occur in conjunction with a
 15 pump because it would anticipated by Coleman. The examiner noted the
 16 identicalness of the pump system in the ‘052 Application and Coleman. *See*
 17 Exhibit X at 27. Defendant’s construction aligns with the file history because it
 18 defines a pump system which is not anticipated by Coleman. Coleman Decl., ¶ 66.

19 **IV. CONCLUSION**

20 The Defendant’s respectfully request that the 18 contested limitations be
 21 interpreted as provided in this paper.

22 Dated: June 4, 2018

PLAGER SCHACK LLP

23
 24 BY: /s/ Mark Plager, Esq.
 25 MARK PLAGER, Esq.
 26 MICHAEL SCHACK, Esq.
 27 MICHAEL O'BRIEN, Esq.
 Attorneys for Defendant

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PROOF OF SERVICE

I am employed within the County of Orange, State of California. I am over the age of eighteen years, and not a party to the within action. My business address is: Plager Schack LLP, 16152 Beach Blvd., Suite 207, Huntington Beach, CA 92647. On **June 4, 2018**, I served the within documents:

**DEFENDANT AESTHETIC SKIN SYSTEMS LLC'S MEMORANDUM IN
SUPPORT OF ITS OPENING CLAIM CONSTRUCTION BRIEF**

- by transmitting via electronic mail the document(s) listed above to the email address(es) set forth below on this date before 5:00 p.m.
 - by personally delivering the document(s) listed above to the person(s) at the address(es) set forth below.
 - by placing the document(s) listed above in a sealed envelope with postage thereon fully prepaid, in United States mail in the State of California at Huntington Beach, addressed as set forth:

Brenton R. Babcock, Esq.

Ali S. Razai, Esq.

KNOBBE, MARTENS, OLSON & BEAR, LLP

2040 Main Street, 14th Floor

Irvine, CA 92614

- by placing a true copy thereof enclosed in a sealed envelope, at a station designated for collection and processing of envelopes and packages for overnight delivery by **FedEx** by U.S. post office as part of the ordinary business practices of Plager Schack LLP described below, addressed as follows:

I am readily familiar with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after the date of deposit for mailing in affidavit.

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1
2 I declare under penalty of perjury under the laws of the State of California
3 that the above is true and correct.
4

5 Executed on June 4, 2018, at Huntington Beach, California.
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FIONA ANN COSTELLO

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